

Application Serial No. 10/649,212
Reply to Office Action of November 13, 2008

PATENT
Docket: CU-5984

REMARKS

In the Office Action, dated November 13, 2008, the Examiner states that Claims 1-67 are pending, Claims 1-28 are rejected and Claims 29-50 are allowed.

Rejection under 35 U.S.C. §103(a)

Claims 1-28 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kobayashi (JP 2000-249821, hereinafter Kobayashi JP) in view of Kobayashi (US 2002/0006558, hereinafter Kobayashi US) for the reasons of record. Applicant respectfully disagrees with and traverses this rejection.

The method for manufacturing a conductive pattern forming body recited in Claim 1 (present invention) is characterized in using a pattern forming body substrate which comprises a base material, and a photocatalyst containing layer formed on the base material and comprising a photocatalyst and a binder, and in forming conductive pattern onto the photocatalyst containing layer by using the metal colloid. Accordingly, the present invention comprises, as a pattern forming body substrate, the substrate, which further comprises the photocatalyst. Thus, a conductive pattern forming body manufactured by the method recited in Claim 1 comprises the photocatalyst containing layer which contains a photocatalyst.

On the other hand, the structure for pattern formation recited in Kobayashi JP does not comprise a photocatalyst-containing layer containing a photocatalyst. As such, even if Kobayashi US is applied to Kobayashi JP, the resulting combination would fall short of yielding the presently claimed invention. Applicant respectfully asserts that although the property change layer of Kobayashi JP has characteristics to change its properties through photocatalytic action, it does not comprise photocatalyst.

To support a *prima facie* case of obviousness, the Office Action must establish "a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference." Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in view of *KSR International Co. v. Teleflex Inc.*, 72 Fed. Reg. 57,526 (Oct. 10, 2007).

As mentioned, Applicant respectfully asserts that the cited prior art does not teach or suggest each and every feature of element of rejected Claim 1, such as a

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photocatalyst containing layer comprising a photocatalyst. Accordingly, Applicant respectfully asserts that a prima facie case of obviousness cannot be established.

In addition, unlike Claim 1, Kobayashi JP clearly excludes a possibility or teaches away from using the photocatalyst containing layer containing a photocatalyst (see for example, paragraphs [0009], [0010], [0012], and [0044] of Kobayashi JP).


In view of the foregoing, Applicant respectfully asserts that Claim 1 is allowable over the cited prior art. Since independent Claim 1 is allowable over the prior art, Applicant asserts that all claims depending therefrom are allowable for at least the same reasons, as well as for the features that they recite.

As such, Applicant respectfully requests withdrawal of the present rejection under 35 U.S.C. §103(a).

In light of the foregoing response, all the outstanding objections and rejections are considered overcome. Applicant respectfully submits that this application should now be in condition for allowance and respectfully requests favorable consideration.

Respectfully submitted,

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Date



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